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28 SEP 2007

3M INNOVATIVE PROPERTIES COMPANY  
PO BOX 33427  
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In re Application of  
YOKOYAMA.  
Application No.: 10/595,093  
PCT No.: PCT/US04/26701  
Int. Filing Date: 17 August 2004  
Priority Date: 22 August 2003  
Attorney's Docket No.: 58821US006  
For: PRECURSOR PASTE AND METHOD OF  
PRODUCING THE SAME

DECISION ON  
RENEWED PETITION  
UNDER 37 CFR 1.47(b)

This is a decision on renewed petition under 37 CFR 1.47(b), filed 31 July 2007 to permit petitioner (applicant) to file the above-captioned application on behalf of the non-signing inventor Chikafumi Yokoyama.

**BACKGROUND**

On 25 September 2006, petitioner filed a petition requesting that the above-identified application be accepted under the provisions of 37 CFR 1.47(b).

On 03 January 2007, a decision dismissing the petition was mailed to applicant indicating that applicant had not met the requirements of 37 CFR 1.47(b).

On 3 April 2007, applicant filed a renewed petition under 37 CFR 1.47(b). On 05 July 2007, a decision dismissing the petition was mailed to applicant.

On 31 July 2007, applicant filed a renewed petition under 37 CFR 1.47(b).

**DISCUSSION**

A petition under 37 CFR 1.47(b) must be accompanied by (1) the requisite petition fee, (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage.

Petitioner previously satisfied Items (1), (3), (4) and (6).

With regard to Item (5)<sup>1</sup>, no assignment signed by the inventor has been presented to prove

<sup>1</sup>Regarding Item (5), Section 409.03(f) of the MPEP, **Proof of Proprietary Interest**, states, in part:

When an application is deposited pursuant to 37 CFR 1.47(b), the 37 CFR 1.47(b) applicant

the proprietary interest.

In attempting to prove that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the subject matter to justify filing the application, Petitioner submitted an agreement entitled "Secrecy Agreement" where the employee (nonsigning inventor) agreed to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such agreement is relied upon, a firsthand knowledge statement that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant and that all conditions were met is required.

With the renewed petition, Petitioner submitted the statement of counsel: "I have firsthand knowledge that the invention described in 58821US006 was made by Chikafumi Yokoyama during his employment by Sumitomo 3M." As defined in Black's Law Dictionary, Sixth Edition, firsthand knowledge is "information or knowledge gleaned directly from its source" such as an eyewitness. Such statement must be made from personal knowledge of the matter. Counsel must specify how she has first hand knowledge that the invention was made during Mr. Yokoyama

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must prove that

- (A) the invention has been assigned to the applicant, or
- (B) the inventor has agreed in writing to assign the invention to the applicant, or
- (C) the applicant otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English Language) must be submitted. The assignment must clearly indicate that the invention described in the 37 CFR 1.47(b) application was assigned to the 37 CFR 1.47(b) applicant. A statement under 37 CFR 3.73(b) by the assignee must also be submitted (see MPEP § 324)....

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by a statement of facts by someone with first hand knowledge of the circumstances in which those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the 37 CFR 1.47(b) applicant must demonstrate that he or she otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained other than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the 37 CFR 1.47(b) applicant. The facts in support of any conclusion that a court would award title to the 37 CFR 1.47(b) applicant should be made of record by way of an affidavit or declaration of the person having firsthand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (if other than the United States statute) or a court decision (if other than a reported decision of a federal court or a decision reported in the United States Patents Quarterly) relied on to demonstrate a proprietary interest should be made of record.

employment with the Japanese company Sumitomo 3M Limited. If this is information from an employer of Sumitomo 3M Limited, then the statement should come from the person who has personal knowledge that Mr. Yokoyama's invention was made during his employment.

Furthermore, Petitioner has not provided a copy of the agreement between Sumitomo 3M Limited to 3M Innovative Properties Company, which give the right to file the above identified application as the 37 CFR 1.47(b) applicant. The Acknowledgment of Patent Rights executed by Steven E. Skolnick, Chief Intellectual Property Counsel for Sumitomo 3M Limited is not sufficient to show the transfer of the right to file this application from Sumitomo 3M Limited to 3M Innovative Properties Company.

Finally, a statement under 37 CFR 3.73 (see MPEP 324) is required and has not yet been provided. Item (5) is not yet satisfied.

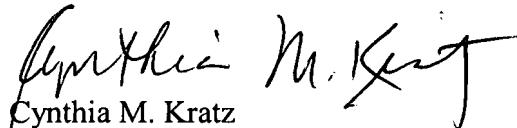
Accordingly, Item (5) above has not been satisfied and the petition under 37 CFR 1.47(b) must be dismissed.

### CONCLUSION

The petition under 37 CFR 1.47(b) is **DISMISSED WITHOUT PREJUDICE**.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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